

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 56, 57 and 61-116 are pending in the application and under active examination.

As a preliminary matter, counsel notes that in the Office Action Summary, item 12(b) was marked, that is the examiner acknowledges applicants' claim for benefit of priority but says that only *some* of the certified copies have been received. The footnote to this marking indicates that the Official Action will provide a list of certified copies not received, however this does not appear to be the case – the full text of the Action does not mention exactly which certified copy (of the three possible) is missing.

In fact, all three certified copies should not missing as they were filed with the filing completion papers dated on October 17, 2001. Note that the cover sheet submitted on that date indicates that certified copies are attached and in proof of this I enclose a copy of the transmittal letter, copies of the first pages of each of the three priority documents as well as a postcard receipt showing the USPTO's receipt of these documents.

On the basis of this information it will be apparent that all of the certified copies have been submitted to the U.S. PTO. Acknowledgement of receipt of all of these certified copies is solicited. If for some reason the Office records are incomplete or unclear, please contact the undersigned by telephone to discuss any concerns the examiner may have in this regard.

Apart from that the record is clear that the necessary filings have been submitted, that the certified copies are of record and that no further action is required by applicants to complete their claim for benefit of priority.

The Official Action includes a double patenting rejection based upon U.S. patents 6,623,557 and 6,737,211. Submitted herewith are Terminal Disclaimers in respect of each of these items thereby resolving these two rejections.

The balance of the Official Action relates to a prior art-based rejection of alleged "obviousness" of claims 56, 57 and 61-116 as being unpatentable over newly cited published U.S. application U.S. 2003/0031615 to Satou et al in view of Winnik, previously of record.

The newly cited document to Satou bears a publication date of February 13, 2003. It also shows a PCT filing date of November 19, 1998. However, the PCT filing date cannot be relied upon as prior art under 35 USC §102(e) for two reasons: the effective date of the amendments

made to Section (e) is November 29, 2000 and as the PCT filing date in question is before that date, the use of this document as prior art under §102(e) is inappropriate. Second, it would appear that the Japanese application was published in Japanese, not English, so this is another reason why it can not be relied upon.

Curiously, the published application does not indicate a U.S. filing date for Serial No. 09/555,073. A check of the public PAIR shows an apparent filing date of May 22, 2000. A copy of a printout from the U.S. PTO website PAIR search is attached. Accordingly, for purposes of this response and based upon the extent of information presently available, applicants will address this document as having an effective date of May 22, 2000.

The published Satou et al document is described in item 4, second paragraph of the Official Action as follows: "The prior art of SATOU discloses (a) composition for inks for jet printers, which has excellent light resistance and water resistance". This is an entirely incorrect characterization of the document cited. In fact, the content and teachings of the reference have nothing to do with inks for inkjet printers and everything to do with *substrate* to which such inks are applied. This will be apparent from even a quick perusal of the document, for instance in paragraph [0001]. "This invention relates to mesoporous silica ... ink absorbents containing the mesoporous silica which are to be used in ink-jet recording sheets, etc., and the recording sheets" and further paragraph [0010] "The invention also provides ink absorbents, ink absorbent slurries and recording sheets which are free from dot blurs, have a high ink-absorptivity and are excellent in water resistance and light resistance". Additional evidence that the Satou reference is concerned with an ink absorbent and/or recording sheets may be found in paragraphs [0024], [0026] and [0027].

It will be noted that, in fact, the mention of "excellent light resistance and water resistance" pertains to the absorbent slurries, ink absorbents and in particular recording sheets and has nothing to do with inks for inkjet printers.

From the above it will be apparent that the Satou publication has nothing to do with the subject matter of the present invention and in any event is incorrectly combined with the Winnik reference, previously addressed. Taken to its logical extreme, the Official Action seems to be suggesting that prior art relating to a nail would be relevant to claims directed to a hammer - hardly the case. In point of fact, the Satou et al publication is not relevant prior art as it is not

pertinent to the invention claimed by applicants nor is it properly combined with the Winnik reference.

Nor does Satou describe information which is reasonably pertinent to the particular problem with which the present inventors are involved.

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering this problem." *In re Clay*, 966 F.2d at 659, 23 U.S.P.Q.2d at 1061.

For the record, the analysis undertaken by the court in *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992), is instructive since it is so similar to the present case. In *Clay*, the court found that a reference in question was not reasonably pertinent to the problem with which the inventor was concerned because a person having ordinary skill in the art would not reasonably have expected to solve the problem faced by the inventor there (dead volume in tanks for refined petroleum) by considering a reference dealing with a refined petroleum) by considering a reference dealing with a separate problem (plugging underground formation anomalies).

Similarly, in the present case a person having ordinary skill in the art of ink for inkjet printers would not reasonably have expected to solve the problem of providing composite coloring particles substantially free from desorbing organic pigments from their surfaces by considering or referring to documents dealing with recording sheets for inkjet printers.

Further, the record does not establish that there is any motivation to combine the teachings of the two quite unrelated documents. It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead one of ordinary skill in the art to combine those references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617-18 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")

Merely asserting that it would have been within the skill of the art to substitute one type of gas for another in the contrast agent of the primary reference is not enough. *In re Fine*,

5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)(Holding that there was no support for the Examiner's mere assertion that it would have been obvious to substitute one type of detector for another in the system of the primary reference); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992)(Holding that there was no suggestion to combine a primary herbicide reference with secondary references directed to shampoo additives or byproducts of mopholines to arrive at the claimed invention.); MPEP § 2143.01.

There is nothing in either of the cited references to suggest the desirability of the combination or modification in the manner indicated by the Examiner. Specifically, there is no motivation or suggestion to combine Satou with Winnik.

Thus, the mere fact that references can be combined or modified (and Applicants believe they cannot be) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. Hence, the Examiner's attempt to combine the cited references alone without any suggestion in the references of the desirability of the modification is improper and should be withdrawn.

Applicants have already addressed and successfully distinguished the present claims from the Winnik et al reference as acknowledged by the examiner on page 5, first paragraph of the current Action. The evidence of record and the examiner's comments hold true – applicants' claims are distinct from and are patentable over the disclosure of Winnik considered alone or even in combination with the seriously-flawed newly cited primary reference of Satou. The rejection based upon the combination of these two documents is illogical, inappropriate and should be withdrawn.

For the above reasons it is respectfully submitted that the claims of this application are in condition for allowance and that this response should be entered, including the two Terminal Disclaimers submitted herewith.

Reconsideration and allowance are solicited. Should the examiner require further information, please contact the undersigned by telephone.

HAYASHI et al.
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Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



Arthur R. Crawford
Reg. No. 25,327

ARC:eaw
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100